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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,508	07/23/2002	Naoyo Isoda	SIMTEK6265	6620

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ERNEST A. BEUTLER  
ATTORNEY AT LAW  
500 NEWPORT CENTER DRIVE  
SUITE 945  
NEWPORT BEACH, CA 92660

EXAMINER

LEWIS, TISHA D

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/064,508

Applicant(s)

ISODA ET AL.

Examiner

TISHA D. LEWIS

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

The following is a first action on the merits of application serial no. 10/064,508, filed on July 23, 2002.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on August 10, 2001. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

#### ***Claim Objections***

Claims 10 and 12 are objected to because of the following informalities:

-In the line 2, before "a clutch", --of-- should be inserted.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwata et al ('399). As to claims 1, 5 and 11, Iwata et al discloses an engine control method including an engine (10) transmitting rotation to driven wheels (18, 19) through a transmission (11) wherein an engine speed is monitored (39) according to variation between an acceleration and deceleration condition to reduce

Art Unit: 3681

engine speed for reducing engine output if the engine speed becomes greater than a predetermined speed to control excessive wheel slippage.

As to claims 2 and 3, Iwata et al discloses the engine speed being measured on every predetermined engine cycle pertaining to crank angle (portion of shaft rotation) and crank position.

As to claims 7 and 8, Iwata et al discloses the engine output also being varied by a spark timing (column 8, lines 50-53) which usually has a set timer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al in view of Ito ('951). Iwata discloses an engine having successive cycles, but does not disclose the type of engine cycle.

Ito discloses an engine control method for restricting engine output if engine speed is excessive wherein the engine is a four cycle having any operating principle (compression and exhaust cycle).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the engine of Iwata et al with a four cycle in view of Ito to prevent over speeding of the engine.

Art Unit: 3681

Claims 10, 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al in view of Sato et al ('674). As to claims 10 and 12, Iwata et al discloses a transmission, but does not disclose if a clutch is used.

Sato et al discloses a transmission control having a clutch wherein an engine speed (input clutch pressure) is reduced to reduce judder/vibration of the transmission.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide Iwata with a vibration/judder control for a clutch/transmission in view Sato et al to eliminate degrade of vehicle drive comfort for the operator.

As to claims 13 and 14, Iwata et al discloses the engine speed being measured on every predetermined engine cycle pertaining to crank angle (portion of shaft rotation) and crank position.

As to claim 16, Iwata discloses the engine speed being monitored (39) according to variation between an acceleration and deceleration condition.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al in view of Sato et al as applied to claim 14 above, and further in view of Ito. Iwata discloses an engine having successive cycles, but does not disclose the type of engine cycle.

Sato discloses an engine having successive cycles, but does not disclose the type of engine cycle.

Art Unit: 3681

Ito discloses an engine control method for restricting engine output if engine speed is excessive wherein the engine is a four cycle having any operating principle (compression and exhaust cycle).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the engine of Iwata et al and Sato et al with a four cycle in view of Ito to prevent over speeding of the engine.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11 and 13-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/064,507. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an engine control having an engine transmitting rotation to driven wheels through a transmission system and detecting during engine acceleration variations in the rotational state of a

Art Unit: 3681

shaft if the degree of change in the variation of the shaft is excessive and restricting an engine output if the change is excessive.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

Claims 6, 9 and 17-20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and upon filing of a terminal disclaimer as stated above in the double patent rejection.

**FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on \_\_\_\_\_ (Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP

Art Unit: 3681

502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### **Conclusion**


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Japanese patent 11325186A, 11287140A, Nozaki ('347), Nishijima et al ('128), Toukura ('371), Iwata et al ('703) and Togai et al ('662) are all cited as having engine control wherein an engine output is restricted according to an vehicle abnormality.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

  
Tisha D Lewis  
Patent Examiner  
Au 3681 8-8-03